

sector 4  
H

Dkt. 54205-B/JPW/SHS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : John O'Connor and Steven Birken  
Serial No. : 09/311,428  
Filed : May 13, 1999  
For : METHODS FOR PREDICTING PREGNANCY OUTCOME IN  
A SUBJECT BY hCG ASSAY

1185 Avenue of the Americas  
New York, New York 10036  
November 29, 1999

Assistant Commissioner for Patents  
Washington, D.C. 20231

ATTN: Box Missing Parts

Sir:

**COMMUNICATION IN RESPONSE TO  
JUNE 9, 1999 NOTICE TO FILE MISSING PARTS OF  
APPLICATION AND PETITION FOUR-MONTH EXTENSION OF TIME**

This Communication is filed in response to a Notice to File Missing Parts of Application issued by the United States Patent and Trademark Office on June 9, 1999 in connection with the above-identified application. A copy of the Notice is attached hereto as Exhibit A. The Notice provides a period of two months for filing a response. Accordingly, a response was originally due on August 9, 1999. Applicants hereby request a four month extension of time. Applicants are hereby establishing small entity status. The fee for a four month extension of time for a small entity is \$680.00 and a check which includes this amount is enclosed. Therefore a response is now due December 9, 1999. Accordingly, this Communication is being timely filed.

The Notice indicates that the oath and declaration is missing. In response, applicants attach hereto as Exhibit B a Declaration and Power of Attorney pursuant to 37 C.F.R. §1.53(d) and in compliance with 37 C.F.R. §163. The Declaration refers to the application's above-identified serial number and filing date.

Applicants : John O'Connor and Steven Birken  
Serial No. : 09/311,428  
Filed : May 13, 1999  
Page 2

The Notice indicates that applicants owe a \$130.00 surcharge under 37 C.F.R. §1.116(e). In response, applicants maintain that small entity status was applicable at the time of filing and that such status still applies. Applicants attach hereto as Exhibit C a Verified Statement (Declaration) Claiming Small Entity Status Under 37 C.F.R. §1.9(f) and §1.27(d) (Non-Profit Organization). The Statement is signed by an authorized official of the entity who has rights in the subject application, namely The Trustees of Columbia University in the City of New York. Since small entity status is applicable, applicants maintain that the surcharge under 37 C.F.R. §1.16(e) for filing the Declaration and Power of Attorney is \$65.00 for a small entity and a check which includes this amount is enclosed.

In addition, in the event that the United States Patent and Trademark Office charged any fees in addition to those required for a small entity, applicants hereby request a refund for any such fees. This refund should be credited to Deposit Account No. 03-3125 under Docket No. 54205-B.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

Applicants : John O'Connor and Steven Birken  
Serial No. : 09/311,428  
Filed : May 13, 1999  
Page 3

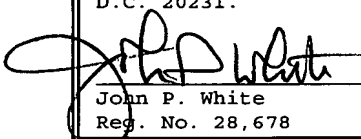
No fee, other than the enclosed \$745.00 which includes the \$65.00 surcharge fee and \$680.00 fee for a four month extension of time is deemed necessary in connection with the filing of this Communication. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White  
Registration No. 28,678  
Attorney for Applicants  
Cooper & Dunham, LLP  
1185 Avenue of the Americas  
New York, New York 10036  
(212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.



John P. White  
Reg. No. 28,678

11/29/99

Date



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO./TITLE
09/311,428	05/13/99	O'DONNOR	J 54205-B/JPW/

ALBERT WAI-KIT CHAN  
COOPER AND DUNHAM LLP  
1185 AVENUE OF THE AMERICAS  
NEW YORK NY 10036

0242/0609

NOT ASSIGNED

1742

DATE MAILED:

06/09/99

**NOTICE TO FILE MISSING PARTS OF APPLICATION**  
*Filing Date Granted*

An Application Number and Filing Date have been assigned to this application. The items indicated below, however, are missing. Applicant is given **TWO MONTHS FROM THE DATE OF THIS NOTICE** within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). **If any of items 1 or 3 through 5 are indicated as missing, the SURCHARGE set forth in 37 CFR 1.16(e) of ☐ \$65.00 for a small entity in compliance with 37 CFR 1.27, or ☒ \$130.00 for a non-small entity, must also be timely submitted in reply to this NOTICE to avoid abandonment.**

***If all required items on this form are filed within the period set above, the total amount owed by applicant as a***

☐ small entity (statement filed) ☒ non-small entity is \$ 131,000

- ☐ 1. The statutory basic filing fee is:

☒ missing.

☐ insufficient.

Applicant must submit \$\_\_\_\_\_ to complete the basic filing fee and/or file a small entity statement claiming such status (37 CFR 1.27).

- ☐ 2. The following additional claims fees are due:

\$\_\_\_\_\_ for \_\_\_\_\_ total claims over 20.

\$\_\_\_\_\_ for \_\_\_\_\_ independent claims over 3.

\$\_\_\_\_\_ for multiple dependent claim surcharge.

*Applicant must either submit the additional claim fees or cancel additional claims for which fees are due.*

- ☐ 3. The oath or declaration:

☒ is missing or unsigned.

☐ does not cover the newly submitted items.

An oath or declaration in compliance with 37 CFR 1. 63, including residence information and identifying the application by the above Application Number and Filing Date is required.

- ☐ 4. The signature(s) to the oath or declaration is/are by a person other than inventor or person qualified under 37 CFR 1.42, 1.43 or 1.47.

**A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.**

- ☐ 5. The signature of the following joint inventor(s) is missing from the oath or declaration:

*An oath or declaration in compliance with 37 CFR 1.63 listing the names of all inventors and signed by the omitted inventor(s), identifying this application by the above Application Number and Filing Date, is required.*

6. A \$50.00 processing fee is required since your check was returned without payment (37 CFR 1.21(m)).

- ☐ 7. Your filing receipt was mailed in error because your check was returned without payment.

- ☐ 8. The application was filed in a language other than English.

Applicant must file a verified English translation of the application, the \$130.00 set forth in 37 CFR 1.17(k), unless previously submitted, and a statement that the translation is accurate (37 CFR 1.52(d)).

- ☐ 9. OTHER:

**Direct the reply and any questions about this notice to "Attention: Box Missing Parts."**

***A copy of this notice MUST be returned with the reply.***